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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/563,062

Applicant(s)

PARK ET AL.

Examiner

ABIGAIL FISHER

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-37 and 39-46 is/are pending in the application.
- 4a) Of the above claim(s) 39-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-37, 45 and 46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date 3/11/08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Receipt of Amendments/Remarks filed on May 8 2008 is acknowledged. Claims 2 and 38 were/stand cancelled. Claims 1, 6, 11, 16, 18 and 29 were amended. Claims 45-46 were added. Claims 1, 3-37 and 39-46 are pending. Claims 39-44 are withdrawn as being directed to a non-elected invention. Claims **1, 3-37 and 45-46** are directed to the elected invention.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on March 11 2008 was considered by the examiner.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-37 and 45-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 as currently written is vague and indefinite. Applicant is claiming a composition comprising doped titanium dioxide and/or zinc oxide and/or reduced zinc oxide. However Applicant further claims, via a wherein clause, that the titanium dioxide and/or zinc oxide is not doped or reduced. The statement after the wherein clause causes the claim to be indefinite because it is contradicting what is stated earlier in the

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body of the claim. Wherein clauses are typically utilized as limiting clauses. **Note MPEP 2106.** Therefore, it would appear that the phrase after wherein should be limiting. However, this would be eliminating the exact components that are claimed earlier in the body of the claim. Consequently, the claims will be interpreted as containing only doped titanium dioxide and/or zinc oxide and/or reduced zinc oxide.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 11-24, 26-29, 35 and 37 rejected under 35 U.S.C. 102(b) as being anticipated by Mitchnick et al. (US Patent No. 5441726, cited on PTO Form 1449).

Applicants have stated that an organic component which may be degraded is generally a UV sunscreen agent (specification, page 4, lines 5-6).

Applicants have defined polymeric composition to mean a composition which comprises one or more polymeric materials (specification, page 12, lines 25-27).

Mitchnick et al. discloses two ways of preparing zinc oxide particles. One way is through doped zinc oxide particles (figure 5 and column 9, lines 40-68). These particles are then exemplified as being utilized in sunscreen creams, emulsions (examples of column 12). The first example is an emulsion comprising the zinc oxide and octyl methoxycinnamate (an organic sunscreen). This emulsion comprises 5% of the doped

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zinc oxide and 7.5% octyl methoxycinnamate. The emulsion additionally comprises dimethicone (a silicone polymer). It is disclosed that the rods having a length of less than 300 nm are optimal to confer transparency to the composition. An example of such a composition is a sunscreen, of which several formulations are provided (column 10-11, lines 65-68 and 1-3).

With regard to the functional limitations pertaining claim 16, claim 19, claim 20, and claims 27-29, Mitchnick et al. discloses the same claimed composition comprising organic components and doped zinc oxide. Note MPEP 2112.02 (11): "Products of identical chemical composition can not have mutually exclusive properties." A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705,709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

Regarding claim 35, since Mitchnick et al. discloses the composition as a sunscreen composition, it would necessarily be a coating composition and subsequently reads on the instant claim.

Regarding claim 37, octyl methoxycinnamate is an ethylenically unsaturated compound and subsequently reads on the instant claim.

Response to Arguments

Applicants' argue that there are not examples in Mitchnick et al. that are directed to compositions comprising (i) an ingredient that is adversely affected by UV light in the

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presence of titanium dioxide and/or zinc oxide, (ii) doped titanium dioxide and/or zinc oxide and/or reduced zinc oxide and (iii) non-doped or reduced titanium dioxide and/or zinc oxide.

Applicant's arguments filed May 8 2008 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., non-doped or reduced titanium dioxide and/or zinc oxide) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The presence of the wherein clause which is a limiting clause renders the claims indefinite. Therefore non-doped or reduced titanium dioxide and/or zinc oxide is not interpreted as a component of the invention.

Claims 1, 3-5, 7-8, 11, 16-20, 26-35 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Chopoorian (US Patent No. 3314321, cited on PTO Form 1449).

Applicants have indicated that components which are adversely affected by titanium dioxide and/or zinc oxide are those which are sensitive to free radical attack. Such components include large molecules such as polymers as well as small molecules such as those with ethylenic unsaturation or those which possess a labile hydrogen atom (specification, page 3, lines 9-13).

Chopoorian is directed to a photochromatic composition comprising inorganic metal oxides suspended in polyester binders. Examples 6 and 7 comprise a polyester resin produced from maleic anhydride, phthalic anhydride, and propylene glycol. It is indicated that these resins contain ethylenic unsaturation (column 5, lines 24-25). Therefore these resins are those ingredients which are adversely affected by UV light in the presence of titanium dioxide and/or zinc oxide. The composition also comprises titanium dioxide that is doped with 0.2% manganese. The doped metal oxide is present in 20% by weight. It is disclosed that these composition have many uses some include temporary photographic proofs (e.g. photographic film) (column 9, lines 21-24). It is disclosed that the polyester resins are thermoplastic and thermosetting (column 1, lines 46-47). It is disclosed that the rutile form of the titanium dioxide is sufficient (column 3, lines 49-50).

With regard to the functional limitation pertaining to claim 16, claim 19, claim 20), and the ingredient which is adversely affected by titanium dioxide and/or zinc oxide suffers a change in physical properties (claims 27-29), Chopoorian discloses the same claimed organic components and doped zinc oxide. Note MPEP 2112.02 (11): "Products of identical chemical composition can not have mutually exclusive properties." A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705,709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

Regarding claim 35, the mixture that is formed from the resin and doped metal oxide, is poured between glass plates (see example 1), therefore it coats the glass plates. This makes the mixture a coating composition and therefore reads on the instant claim.

Response to Arguments

Applicants' argue that there are not examples in Mitchnick et al. that are directed to compositions comprising (i) an ingredient that is adversely affected by UV light in the presence of titanium dioxide and/or zinc oxide, (ii) doped titanium dioxide and/or zinc oxide and/or reduced zinc oxide and (iii) non-doped or reduced titanium dioxide and/or zinc oxide.

Applicant's arguments filed May 8 2008 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., non-doped or reduced titanium dioxide and/or zinc oxide) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The presence of the wherein clause which is a limiting clause renders the claims indefinite. Therefore non-doped or reduced titanium dioxide and/or zinc oxide is not interpreted as a component of the invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Applicant Claims
2. Determining the scope and contents of the prior art.
3. Ascertaining the differences between the prior art and the claims at issue, and resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 10, 36 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitchnick et al.

Applicant Claims

Applicant claims a composition comprising an ingredient which is adversely affected by UV light in the presence of titanium dioxide and/or zinc oxide, and an amount of titanium dioxide and/or zinc oxide which is doped with one or more elements and/or reduced zinc oxide.

A dependent claim indicates that the titanium dioxide and/or zinc oxide is coated with an inorganic or organic solvent.

A dependent claim indicates that the composition is in the form of a paint or varnish.

Determination of the Scope and Content of the Prior Art (MPEP §2141.01)

The teachings of Mitchnick et al. are set forth above. The dopants include Bi and aluminum (column 10). Mitchnick et al. discloses that the zinc oxide may be combined with other metal oxides such as titanium oxides (column 11, lines 6-9). The second sunscreen formulation exemplifies using microfine titanium dioxide in combination of zinc oxide. The zinc oxide may be surface modified in order to make them more compatible in a given formulation. One example of a surface modification is a silicone-like compound in order to increase the zinc oxides compatibility with oil-based formulations (column 11, lines 17-21). One example includes an opaque paint. It is disclosed that coating inanimate objects result in material that is more resistant to the fading brought on by exposure to UV light (column 4, lines 30-34).

***Ascertainment of the Difference Between Scope the Prior Art and the Claims
(MPEP §2141.012)***

Mitchnick et al. does not exemplify utilizing titanium dioxide and/or zinc oxide that are coated with an organic solvent.

Mitchnick et al. does not exemplify a paint formulation comprising organic components.

***Finding of Prima Facie Obviousness Rational and Motivation
(MPEP §2142-2143)***

As a general principle it is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose, the idea of combining them flows logically from their having been individually taught in the prior art. See *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980) **MPEP 2144.06**.

It would have been obvious to one of ordinary skill in the art to utilize particles that had been coated with an organic solvent. One of ordinary skill in the art would have been motivated to coat the particles because Mitchnick et al. discloses that surface modified make them more compatible in a given formulations. Therefore depending on the desired formulation of the particles to be used, making the particles coated makes them more compatible with the formulations.

It would have been obvious to one of ordinary skill in the art to include UV absorbers in the paint exemplified by Mitchnick et al. One of ordinary skill in the art would have been motivated to include this type of ingredient because Mitchnick et al. discloses that the compositions can be applied to inanimate objects to make them more resistant to UV light. If the paint were to be used the addition of UV absorbers would be

reasonably expected to have an additive effect thereby lengthening the life of the compositions. Absent any evidence to the contrary, and based upon the teachings of the prior art, there would have been a reasonable expectation of success in practicing the instantly claimed invention.

Response to Arguments

Applicants' argue that there are not examples in Mitchnick et al. that are directed to compositions comprising (i) an ingredient that is adversely affected by UV light in the presence of titanium dioxide and/or zinc oxide, (ii) doped titanium dioxide and/or zinc oxide and/or reduced zinc oxide and (iii) non-doped or reduced titanium dioxide and/or zinc oxide.

Applicant's arguments filed May 8 2008 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., non-doped or reduced titanium dioxide and/or zinc oxide) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The presence of the wherein clause which is a limiting clause renders the claims indefinite. Therefore non-toped or reduced titanium dioxide and/or zinc oxide is not interpreted as a component of the invention.

Claims 6, 17-18 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chopoorian.

Applicant Claims

Applicant claims a composition comprising an ingredient which is adversely affected by UV light in the presence of titanium dioxide and/or zinc oxide, and an amount of titanium dioxide and/or zinc oxide which is doped with one or more elements and/or reduced zinc oxide.

The dopant is present in an amount from or 0.5 to 2 mole %.

A dependent claim indicates that the composition contains a UV sunscreen agent.

Determination of the Scope and Content of the Prior Art (MPEP §2141.01)

The teachings of Chopoorian are set forth above. Additionally, it is indicated that the admixtures contain from about 0.01 to 5 mole% of the doping guest oxide (column 3, lines 53-55). It is also indicated that it is possible to lengthen the life of the composition by incorporating various ultraviolet light absorbers into them. These additives include UV absorbers such as 2-hydroxy benzophenone (column 9, lines 30-40). When these absorbers are added they are present in amount up to 20% by weight (column 9, lines 43-45).

Ascertainment of the Difference Between Scope the Prior Art and the Claims (MPEP §2141.012)

Chopoorian does not exemplify utilizing titanium dioxide that is doped in different percentages.

Chopoorian does not exemplify utilizing UV absorbers in the composition of matter.

***Finding of Prima Facie Obviousness Rational and Motivation
(MPEP §2142-2143)***

It would have been obvious to one of ordinary skill in the art to utilize a dopant in an amount from about 0.01 to 5 mole% . One of ordinary skill in the art would have been motivated to select this range because it is disclosed by Chopoorian as being suitable. Therefore one of ordinary skill in the art would have a reasonable expectation that these particles would function effectively with this particular amount of dopant.

It would have been obvious to one of ordinary skill in the art to include UV absorbers in the compositions of matter of Chopoorian. One of ordinary skill in the art would have been motivated to include this type of ingredient because Chopoorian indicates that the inclusion of these types of ingredients may lengthen the life of the compositions.

Response to Arguments

Applicants' argue that there are not examples in Mitchnick et al. that are directed to compositions comprising (i) an ingredient that is adversely affected by UV light in the presence of titanium dioxide and/or zinc oxide, (ii) doped titanium dioxide and/or zinc oxide and/or reduced zinc oxide and (iii) non-doped or reduced titanium dioxide and/or zinc oxide.

Applicant's arguments filed May 8 2008 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., non-doped or reduced titanium dioxide and/or zinc oxide) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The presence of the wherein clause which is a limiting clause renders the claims indefinite. Therefore non-doped or reduced titanium dioxide and/or zinc oxide is not interpreted as a component of the invention.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mitchnick et al. in view of Knowland et al. (WO 99/60994, cited on PTO Form 1449).

Applicant Claims

Applicant claims a composition comprising an ingredient which is adversely affected by UV light in the presence of titanium dioxide and/or zinc oxide, and an amount of titanium dioxide and/or zinc oxide which is doped with one or more elements and/or reduced zinc oxide.

A dependent claim indicates that reduced zinc oxide is present.

Determination of the Scope and Content of the Prior Art (MPEP §2141.01)

The teachings of Mitchnick et al. are set forth above.

Knowland et al. teaches UV screening compositions comprising particles capable of absorbing UV light. The particles may be reduced zinc oxide particles (page 4, lines

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6-8). The particles may also be titanium or zinc oxide that has been doped with nickel, iron, chromium, aluminum, manganese, among others (page 5, lines 1-7).

***Ascertainment of the Difference Between Scope the Prior Art and the Claims
(MPEP §2141.012)***

Mitchnick et al. does not disclose utilizing reduced zinc oxide. For this reason Knowland et al. is relied upon.

***Finding of Prima Facie Obviousness Rational and Motivation
(MPEP §2142-2143)***

It would have been obvious to one of ordinary skill in the art to utilize reduced zinc oxide in the sunscreen formulations of Mitchnick et al. One of ordinary skill in the art would have been motivated to utilize these particles as they are disclosed in Knowland et al. as being other suitable doped particles for use in sunscreen compositions. Therefore one of ordinary skill in the art would have a reasonable expectation that these particles would function the same as the doped zinc oxide of Mitchnick et al.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

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1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 4-29 and 45 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-25 of copending Application No. 10/540649. Although the conflicting claims are not identical, they are not patentably distinct from each other because they overlap in scope.

Both applications are directed to composition which comprise doped titanium dioxide and/or zinc oxide and/or reduced zinc oxide. Copending '649 claims an organic component while the instant application claims an ingredient which is adversely affected by UV light in the presence of titanium dioxide and/or zinc oxide. A particular species of organic component as well as ingredient which is adversely affected is a UV sunscreen agent. Copending '649 claims all the instant limitations in the dependent claims. Therefore, both the instant application and '062 are directed to similar subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1, 3-36 and 45 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 8, 10-12, 16-20, 24-32, 34, 36, 50-52, and 54-55 of copending Application No. 10/588071. Although the conflicting claims are not identical, they are not patentably distinct from each other because they overlap in scope.

Both applications are directed to compositions which comprise doped titanium dioxide and/or zinc oxide, and an ingredient which is adversely affected by UV light in the presence of titanium dioxide and/or zinc oxide. Copending '071 claims all the instant limitations in the dependent claims. Therefore, both the instant application and '071 are directed to similar subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1 and 3-36 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14, 16-23, 27, 28, of copending Application No. 10/555570. Although the conflicting claims are not identical, they are not patentably distinct from each other because they overlap in scope.

Both applications are directed to compositions which comprise doped titanium dioxide and/or zinc oxide, and/or reduced zinc and organic components. The composition of copending '570 comprises organic or inorganic components which are degraded by another ingredient of the composition. The instant application claims an

ingredient which is adversely affected by UV light in the presence of titanium dioxide and/or zinc oxide. A particular species of organic component as well as ingredient which is adversely affected is a UV sunscreen agent. Copending '570 claims all the instant limitations in the dependent claims. Therefore, both the instant application and '071 are directed to similar subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1, 3-25 and 45 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14, 16-17, and 20-21 of copending Application No. 11/054188 and 11/207408 in view of Mitchnick et al.

The instant application is directed to composition comprising an ingredient which is adversely affected by UV light in the presence of titanium dioxide and/or zinc oxide and doped titanium dioxide and/or zinc oxide and/or reduced zinc.

Copending '188 and '408 claims a UV screening composition comprising particles. The particles as claimed include a reduced zinc oxide, or zinc oxide and titanium dioxide with a second component. The second components overlap with the dopants of the instant application.

Copending '188 and '408 do not claim that sunscreen agent can be added. Copending '188 and '408 does not claim the composition is in the form of a lotion, gel, etc. or that the particles can be coated. However, Mitchnick et al. indicates that when

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formulating these particles into a sunscreen composition that other sunscreen components can be added (column 11, lines 54-56). Mitchnick et al. indicates that the preparation of sunscreens in the form of creams and lotions is well known in the art (column 11, lines 49-50). The zinc oxide may be surface modified in order to make them more compatible in a given formulation. One example is silicone-like compound in order to increase the zinc oxides compatibility with oil-based formulations (column 11, lines 17-21).

Therefore, it would have been obvious to one of ordinary skill in the art to formulate the UV screening composition of '188 and '408 in to a cream or lotion as it was known that these are well known forms of sunscreens. It would have been obvious to one of ordinary skill in the art to utilize coated particles. One of ordinary skill in the art would have been motivated to coat the particles because Mitchnick et al. discloses that surface modified make them more compatible in a given formulations. Therefore depending on the desired formulation of the particles will be used, making the particles coated makes them more compatible with the formulations.

This is a provisional obviousness-type double patenting rejection.

Claims 1, 3-6, 10-29 and 45 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4, 7-8, and 10 of U.S. Patent No. 6869596 in view of Mitchnick et al.

The instant application is directed a composition comprising an ingredient which is adversely affected by UV light in the presence of titanium dioxide and/or zinc oxide,

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and doped titanium dioxide and/or zinc oxide and/or reduced zinc. Patent '596 claims a UV screening composition comprising zinc oxide particles incorporating manganese or chromium. The and/or language of the instant application indicates that the only particles present may be doped zinc oxide. Therefore the particles are the same between the two.

Patent '569 does claim that sunscreen agent can be added therefore it would have been obvious to one of ordinary skill in the art to include them in the UV screening compositions.

Patent '596 does not claim the composition is in the form of a lotion, gel, etc. or that the particles can be coated. However Mitchnick et al. indicates that the preparation of sunscreens in the form of creams and lotions is well known in the art (column 11, lines 49-50). The zinc oxide may be surface modified in order to make them more compatible in a given formulation. One example is silicone-like compound in order to increase the zinc oxides compatibility with oil-based formulations (column 11, lines 17-21).

Therefore, it would have been obvious to one of ordinary skill in the art to formulate the UV screening composition of '596 in to a cream or lotion as it was known that these are well known forms of sunscreens. It would have been obvious to one of ordinary skill in the art to utilize coated particles. One of ordinary skill in the art would have been motivated to coat the particles because Mitchnick et al. discloses that surface modified make them more compatible in a given formulations. Therefore

depending on the desired formulation of the particles will be used, making the particles coated makes them more compatible with the formulations.

Response to Arguments

Applicants' argue that there are not examples in Mitchnick et al. that are directed to compositions comprising (i) an ingredient that is adversely affected by UV light in the presence of titanium dioxide and/or zinc oxide, (ii) doped titanium dioxide and/or zinc oxide and/or reduced zinc oxide and (iii) non-doped or reduced titanium dioxide and/or zinc oxide.

Applicant's arguments filed May 8 2008 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., non-doped or reduced titanium dioxide and/or zinc oxide) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The presence of the wherein clause which is a limiting clause renders the claims indefinite. Therefore non-toped or reduced titanium dioxide and/or zinc oxide is not interpreted as a component of the invention.

Regarding the last non-statutory double-patenting rejection over U.S. Patent No. 6869596, the examiner would like to note that the US Patent No. listed in the previous office action was mistakenly written. The last two numbers of the patent number were

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reversed. The correct patent number is 6869596 not 6869569. Since this is a non-statutory double patenting rejection the patent must be either commonly owned or have one common inventor. Therefore, the Applicants should be aware of their own work and easily recognize the accidental flip of the last two numbers of the patent. Furthermore, the examiner clearly indicated the what the patent was directed to in the Office action.

Conclusion

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to ABIGAIL FISHER whose telephone number is (571)270-3502. The examiner can normally be reached on M-Th 9am-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Abigail Fisher
Examiner
Art Unit 1616

AF

/Mina Haghighatian/
Primary Examiner, Art Unit 1616